



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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GROUP 3600

Applicant: Robert B. Hope
Serial No.: 10/033,518
Filed: December 28, 2001
For: WEATHER SEAL HAVING ELASTOMERIC MATERIALS
ENCAPSULATING A BENDABLE CORE
Examiner: Jerry E. Redman Art Unit: 3634
Atty. Docket: ULB-003CV

SECOND SUPPLEMENTAL APPEAL BRIEF UNDER Rule 193(2)(ii)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully submits the following brief in support of his appeal of the Final Rejection of Claims 1-10 (all of the claims now standing) in the above-identified application, and requests reinstatement of this Appeal under Rule 193(2) (ii).

This brief is further in response to the Notice of June 23, 2004 (paper 12).

(1) Real Party In Interest

Applicant's Assignee, Ultrafab, Inc., of Farmington, New York, is the Real Party In Interest in this case.

(2) Related Appeals and Interferences

There are no Appeals or Interferences related to this Appeal or to this application.

(3) Status of Claims

Claims 1-10 are pending and all of these claims are forwarded for consideration on this Appeal.

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(4) Status of Amendments

A Response was filed on February 11, 2003 to the Final Rejection of January 23, 2003. The claims were not amended in this Response. The Response contains reasons, both factual and legal, supporting the allowance of the claims which were finally rejected and are now on appeal.

In an Advisory Action dated March 5, 2003, the Examiner maintained his Final Rejection stating, "the claims still read on the art of record".

On or about March 10, 2003, Counsel contacted the Examiner and attempted to ascertain the basis of the Examiner's statement in the Advisory Action. No cognizant reasons were solicited thereby predicated this Appeal.

On July 16, 2003, the Examiner issued a non-final action citing new references and combining them to reject all of the claims under 35 U.S.C. §103(a).

In a Request for Reinstatement of Appeal and Supplemental Brief filed September 5, 2003, it was contended that reopening of prosecution only merely presenting a new non-final action was out of order. That Request for Reinstatement and Supplemental Brief is hereby incorporated by this reference in this Second Supplemental Appeal Brief.

On June 23, 2004 (Paper 12) the Examiner responded by requiring a "new and complete brief in response to the rejection dated July 16, 2003" (the new non-final action discussed above).

In order to expedite prosecution, the Second Supplemental Brief is submitted.

Since the final rejection of January 23, 2003 has not been officially withdrawn the material in the initial brief concerning the setting forth the errors in the final rejection are retained in this Second Supplemental Brief.

(5) Summary of Invention

This invention relates to weather seals for sealing body parts such as windows, doors and trunks of automotive vehicles (cars and trucks) (page 1, first paragraph). The invention has two aspects. The first deals with the encapsulation of the core (the wire carrier 12, FIGS. 2 and 3) with a substrate or encapsulating filler 20 of recycled elastomeric material which is then covered with virgin elastomeric material (paragraph bridging pages 2 and 3, FIGS. 2 and 3, fourth full paragraph on page 6). Preferably, as

shown in FIGS. 3 and 4, the substrate is applied as tape; preferably extruded as molten tapes 30 and 32 sandwiching the core or carrier 12 and its reinforcing elements 14 (paragraph bridging pages 6 and 7 and first full paragraph on page 7).

The principal advantage of the use of the substrate is to reduce the cost of the weather seal. Other advantages are to improve the integrity of the weather seal. These advantages are spelled out from lines 5-25 on page 3.

The second aspect of the invention is to provide a core and carrier which avoids the need for reinforcement elements of knitted yarn (paragraph bridging pages 3 and 4). These reinforcement elements 42 are laid down only on one side of the core (the loops of the carrier 12) (page 7, lines 16 and 17). The core 12 is carried around a wheel 56 and the plurality of reinforcing elements 90 are fed onto one side of the elements on the wheel. The elements are attached to the core at a processing station 80 (FIG. 8A) as by glue from a dispenser 84 (see FIG. 11). The substrate and sealing layers are then applied over the core and the reinforcing elements (the summary and last full paragraph on page 4, and first full paragraph on page 8).

(6) Issues

(a) The issue presented by the Final Rejection is whether any of the claims are anticipated by Weichman, U.S. Patent No. 4,517,233, under 35 U.S.C. §102(b).

(b) The issue presented by the non-final action of July 16, 2003 is whether any of the claims are unpatentable over Keys, U.S. Patent No. 5,221,564 in view of a Japanese Patent Publication JP 11279290 of October 12, 1999, and in the case of Claims 2, 6, 7, 9 and 10 also in view of Vinay, U.S. Patent No. 5,416,961.

(7) Grouping of Claims

The first aspect of the invention is set forth in Claims 1-4 and 8. An important feature of the invention is to provide the substrate of recycled elastomeric material in the form of a tape or tapes which encapsulate the core and this aspect is in Claims 3, 4 and 8. Another group is of Claims 5-7, 9 and 10. These are product by process claims which define the weather seal in terms of the use of a wheel to carry the core and define a space where the reinforcing elements are applied, the nature of these elements and the process

by which they are attached, namely application of adhesive, fusion bonding, or encapsulation.

With respect to the 35 U.S.C. §102(b) rejection, the claims do not stand or fall together, and are in three claims groups:

Group I - Claims 1 and 2;

Group II - Claims 3, 4 and 8; and

Group III - Claims 5-7, 9 and 10.

(8) Argument

It is respectfully submitted that the final rejection of the claims in this case as being anticipated by Weichman, U.S. Patent No. 4,517,233, is in error and should be reversed in that elements of the claimed invention are not present in this reference and the reference is not anticipatory.

Weichman shows a core or carrier made up of two distinct loops 16 and 18 which are held together by interweaving the loops with yarn-type reinforcing elements (column 3, lines 45-63). This core is coated with an elastomeric material 36, which is shown as a single coating of one body of material.

Claims 1 and 2 are not met because the element of the weather seal, a substrate of recycled elastomeric material encapsulating the core and a covering of virgin elastomeric material providing a sealing surface are both not shown in any form equivalent or otherwise in Weichman.

The use of tape or tapes of the recycled material as the substrate as set forth in Claims 3, 4 and 8 is also and similarly not shown or apparent from Weichman, and thus such claims are separately patentable from other claims on Appeal.

Nothing is disclosed in Weichman as to the use of a wheel for carrying a weather seal core and applying reinforcing elements to one side of the core as the wheel rotates. The inner sinus wire 18 of the Weichman core is not a reinforcing element. If it were, the yarn 42 would not be required. It is the yarn which is the only reinforcing element in Weichman, and that yarn is woven around the turns of the sinus wires 16 and 18. Claim 5 defines a weather seal made by applying reinforcing elements along only one side of a core. This limitation also distinguishes over Weichman. Claim 5 and dependent Claims

6-7 and 9-10 are separately patentable from other claims on Appeal by describing the applying and attaching of reinforcing elements not present in Weichman.

Since each and every element of the claims are not found in Weichman, Weichman does not anticipate the invention as claimed under 35 U.S.C. §102(b). See Applied Med. Resources Corp. v. United States Surgical Corp., 147 F.3d 1374,1378 (Fed. Cir. 1998) and United States Filter Corp. v. Ionics, Inc., 68 F. Supp. 2d, 48,52 (D. Mass.) 1999.

The law does not permit an interpretation of Weichman on which anticipation can be based. A patent claim is anticipated only if a comparison of the claimed invention with a single prior art reference establishes clearly and convincingly that every element in the claim is “described, organized, and functioning in substantially the same manner as in the prior art reference.” Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989, 996 (Fed. Cir. 2000) (affirming jury finding of no anticipation); Biacore, AB v. Thermo Bioanalysis Corp., 79 F. Supp. 2d 422, 459 (D. Del. 1999) (finding patent not anticipated and infringed).

Whether a specific reference anticipates a patent claim “is a question of fact.” Rockwell Intern. Corp. v. U.S., 147 F.3d 1358, 1363 (Fed. Cir. 1998). To establish a *prima facie* case of anticipation, the Examiner must prove, therefore, with respect to the claims, that a single prior art reference describes all of the claimed subject matter in its entirety. That description in the prior art reference must contain sufficient detail and clarity to demonstrate that the claimed subject matter existed prior to the invention, and that a person of ordinary skill in the art would have recognized its existence in the proffered prior art reference. See Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1346-47 (Fed. Cir. 2000) (vacating grant of summary judgment of invalidity by anticipation).

Accordingly, there is no anticipation by Weichman. With all due respect, the Examiner has ignored salient limitations in the claims which provide significant improvements in weather seals of the type having wire and similar cores, including Weichman’s, all as explained in the specification.

The rejection of Claim 5 and the claims dependent thereon is in error in that none of the references disclose the use of a wheel for carrying a weather seal core and applying reinforcing elements to one side of the core as the wheel rotates. The inner sinus wire 18

of the Weichman core is not a reinforcing element. If it were, the yarn 42 would not be required. It is the yarn which is the only reinforcing element in Weichman, and that yarn is woven around the turns of the sinus wires 16 and 18. Claim 5 defines a weather seal made by applying reinforcing elements along only one side of a core. This limitation also distinguishes over Weichman. Claim 5 and dependent Claims 6-7 and 9-10 are separately patentable from other claims on Appeal by describing the applying and attaching of reinforcing elements not present in Weichman.

The new rejection on Keys in view of the Japanese Publication under 35 U.S.C. §103(a) is in error since (a) there is no showing of a layer of a substrate of recycled elastomeric material which is encapsulated by a covering of virgin elastomeric material, let alone the use of tapes of the recycled material, and (b) the rejection depends upon a general reference involving the use of recycled elastomeric material (rubber) (the JP Publication) which is not analogous to the invention as claimed and would not support a rejection under 35 U.S.C. §103. Such a rejection would not constitute a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531,1532, 28 U.S.P.Q. 2d, 1955, 1956 (Fed. Cir. 1993). In any event, such a general reference would not constitute evidence that would lead one of ordinary skill in the art to combine the teachings thereof with Keys, to arrive at the claimed invention. See In re Fine, 837 F.2d 1071,1074, 5 U.S.P.Q. 2d, 1596,1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013,1016, 173 U.S.P.Q. 560,562 (CCPA 1972).

The Examiner is also in error in the new non-final action as to his interpretation of Keys. Keys shows no encapsulation layers, Layer 17 butt against the end of Layer 21 at a butt joint 32. Layer 17 is of thermo setting material (noted as EPDM-apparently virgin material). Layer 21 is of thermo plastic (PVC). There are no tapes of recycled EPDM in the Keys seal. There is no encapsulating cover of virgin EPDM.

The Japanese reference relates to making a mixture of rubber including recycled rubber and forming the mixture into a weather seal. This is merely a general reference on use of recycled material, which as already submitted above is not of probative of unpatentability.

Claims 1 and 4-8 call for a substrate of recycled elastomeric material which is encapsulated by virgin material. The Japanese reference is for an integrally formed

structure, nothing like what is claimed. It is beyond peradventure that there is nothing except Applicant's disclosure to suggest (i.e., in hindsight) using a substrate of recycled material over a core covered by an encapsulating layer, let alone specifically as claimed. Clearly, the combination of references is improper under a long line of cases recently including In re Vaeck, 20U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991).

The Examiner is in error in applying the Vinay patent in that the patent shows only a woven warp of threads including a wire and a meltable thread. This patent is discussed and distinguished from the invention claimed by Appellant on page 2, first full paragraph of the specification as filed. Certainly the patent does not teach anything about the core encapsulating layers of recycled and virgin elastomeric material. The warp is not on one side of the core, but is woven around the core wire. Thus, Claims 5, 6, 7, 8, 9, and 10 clearly distinguish by virtue of the unique location of the reinforcing elements unforeshadowed in any reference of record.

For the foregoing reasons, the decision of the Examiner rejecting Applicant's claims should be reversed and the Examiner should be directed to pass this case to Issue.

Dated: July 22, 2004

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Martin LuKacher', written over a horizontal line.

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APPENDIX
Claims On Appeal

1. A weather seal comprising a core, a substrate of recycled elastomeric material encapsulating said core, a covering of virgin elastomeric material providing a sealing surface and encapsulating said core and substrate.

2. The weather seal according to Claim 1 where the core is a wire loop carrier.

3. The weather seal according to Claim 1 wherein the recycled material is cured EPDM or TPR which is applied in molten or semi-molten form as a tape or tapes.

4. The weather seal according to Claim 3 wherein the material is extruded to form said tape or tapes.

5. A weather seal comprising a core, longitudinal extension control and reinforcing elements applied along only one side of said core by carrying said core around a wheel which exposes a space thereof, applying said element through said space as said wheel rotates, and attaching said elements to said core in said space after application.

6. The weather seal according to Claim 5 wherein said core is a wire loop carrier and elements are yarns, selected from the group consisting of polyester strands, fiberglass strands, metal wires and monofilaments.

7. The weather seal according to Claim 6 wherein said attaching step is carried out by chemical bonding, with adhesive applied where said elements contact the core.

8. The weather seal of Claim 3, further comprising one or more reinforcement elements adjacent to and along the length of said core on only one side

thereof, said tape encapsulating said core and attaching said reinforcement elements to said core.

9. The weather seal of Claim 6 wherein said attaching step is carried out by fusion bonding.

10. The weather seal of Claim 6 wherein said attaching step is carried out by encapsulation of said elements and said core.